

REMARKS

Summary

Claims 1-49 stand in this application. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested.

Allowable Claims

We would like to thank the Examiner for indicating the allowability of claims 14, 15, 31, 32, 46 and 47 if amended to include all of the limitations of the base claims and any intervening claims. Applicant respectfully submits, however, that these claims represent patentable subject matter as currently listed based on the remarks given for the independent claims as discussed in detail below. Applicant would like to respectfully reserve the right, however, to amend the allowable claims into independent form during further prosecution if warranted.

35 U.S.C. § 103

At page 2 of the Office Action claims 1-6, 12, 13, 16-24, 29, 30, 33-40, 48 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Publication Number 2004/0203977 to Kennedy (“Kennedy”) in view of United States Patent Publication Number 2004/0028199 to Carlson (“Carlson”). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As recited above, to form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. *See* MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 1-6, 12, 13, 16-24, 29, 30, 33-40, 48 and 49. Therefore claims 1-6, 12, 13, 16-24, 29, 30, 33-40, 48 and 49 define over Kennedy and Carlson whether taken alone or in combination. For example, claim 1 recites the following language, in relevant part:

updating contact status information for said group of potential conferees during said automatically setting up said teleconference.

As correctly noted in the Office Action on page 3, the above-recited language is not disclosed by Kennedy. According to the Office Action, the missing language is

disclosed by Carlson at paragraph [0033]. Applicant respectfully disagrees. Carlson at the given cite, in relevant part, states:

The participant information and attributes are then transmitted to host and other participants (410). In certain circumstances, the host may desire to limit the participant information to the host and/or a selected group of participants. In this case, the host may choose to only have the participant status information transmitted to himself and/or a selected group of participants. The transmission of information is received by the other participants through the Internet, by multiplexing the data along the telephone line with the audio signal of the participants, or any other method as determined by those skilled in the art. The host and other participants receive the participant information and attributes on a graphical user interface such as a personal computer 502, modified telephone 504, or control device 510 connected to the telephone. Examples of these devices can be seen in FIGS. 5A, 5B, and 5C. Control program 400 continuously updates the status information sent to the host and other participants until the conference call ends.

By way of contrast, the claimed subject matter teaches “updating contact status information for said group of potential conferees during said automatically setting up said teleconference.”

Applicant respectfully submits that Carlson, arguably, teaches transmitting participant information to the host and to other participants during the conference call. However, Applicant submits that this is different than “updating contact status information for said group of potential conferees during said automatically setting up said teleconference” as recited in independent claim 1. Applicant respectfully submits that Carlson fails to teach, suggest or disclose the transmission of status information during the automatic setting up of the teleconference.

Applicant respectfully submits that the status information in Carlson is transmitted to the host and other participants, as illustrated in Figure 4, after a participant manually connects to the conference call center. In contrast, claim 1 recites “updating contact status information for said group of potential conferees during said automatically setting up said teleconference.” Applicant respectfully submits that the status information in Carlson is not sent during the automatically setting up of a teleconference as recited in claim 1.

Furthermore, Carlson at paragraph [0033], in relevant part, states that “Control program 400 continuously updates the status information sent to the host and other participants until the conference call ends.” Applicant respectfully submits that this language, arguably, indicates that the status information is updated during the conference call, rather than during the automatically setting up of the teleconference as recited in claim 1. Therefore, Carlson fails to disclose, teach or suggest the missing language. Consequently, Kennedy and Carlson, whether taken alone or in combination, fail to disclose, teach or suggest every element recited in claim 1.

Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See MPEP § 2143.03*, for example. Accordingly, removal of the obviousness rejection with respect to claim 1 is respectfully requested. Claims 2-6, 12, 13 and 16-18 also are non-obvious and patentable over Kennedy and Carlson, taken alone or in combination, at least on the basis of their dependency from claim 1. Applicant, therefore, respectfully requests the removal of the obviousness rejection with respect to these dependent claims.

Claims 19 and 37 recite features similar to those recited in claim 1. Therefore, Applicant respectfully submits that claims 19 and 37 are not obvious and are patentable over Kennedy and Carlson, taken alone or in combination, for reasons analogous to those presented with respect to claim 1. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to claims 19 and 37. Furthermore, Applicant respectfully requests withdrawal of the obviousness rejection with respect to claims 20-24, 29, 30, 33-36, 38-40, 48 and 49 that depend from claims 19 and 37 respectively, and therefore contain additional features that further distinguish these claims from Kennedy and Carlson.

At page 3 of the Office Action claims 7-11, 25-29 and 41-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy in view of Carlson and further in view of United States Patent Number 5,058,168 to Knappe et al. (“Knappe”). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

Applicant respectfully submits that if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. As recited above, Applicant respectfully submits that Kennedy and Carlson, taken alone or in combination, fail to teach suggest or disclose each and every element recited in independent claims 1, 19 and 37. Furthermore, Applicant respectfully submits that claims 7-11, 25-29 and 41-45 depend from claims 1, 19 and 37 respectively. Moreover, Applicant respectfully submits that Knappe fails to teach, suggest or disclose the missing language recited in the independent claims as discussed above. Accordingly, removal of the obviousness rejection with respect to claims 7-11,

25-29 and 41-45 is respectfully requested at least on the basis of their dependency from claims 1, 19 and 37. Applicant respectfully requests the removal of the obviousness rejection with respect to these dependent claims.

For at least the reasons given above, claims 1-49 are non-obvious and represent patentable subject matter in view of the cited references, whether taken alone or in combination. Accordingly, removal of the obviousness rejection with respect to claims 1-49 is respectfully requested. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

Appl. No. 10/602,466

Response Dated March 27, 2007

Reply to Office Action of November 27, 2006

Docket No.: 1070P3820

Examiner: Smith, Creighton H.

TC/A.U. 2614

It is believed that claims 1-49 are in allowable form. Accordingly, a timely
Notice of Allowance to this effect is earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if
such contact would further the examination of the present patent application.

Respectfully submitted,

KACVINSKY LLC



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Under 37 CFR 1.34(a)

Dated: March 27, 2007

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